

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DANIEL J. WHITE,  
PAUL S. WHITE and ADAM M. CASALENA

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Appeal 2007-0420  
Application 10/643,383  
Technology Center 1700

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Decided: April 27, 2007

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Before: RICHARD E. SCHAFER, TEDDY S. GRON, and  
CAROL A. SPIEGEL, *Administrative Patent Judges*.

GRON, *Administrative Patent Judge*.

DECISION ON APPEAL

Introduction

This case is an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of Claims 11-13 of Application 10/643,383, filed August 19, 2003, under 35 U.S.C. § 103(a) in view of Alexandres, U.S. Patent

5,298,712, patented March, 29, 1994, the acknowledged prior art in applicants' application, and Hooke, U.S. Patent 4,322,597, patented March 30, 1982. Claims 11-13 are transcribed below (Appendix A to the Appeal Br.):

11. A method for manufacturing a battery pack comprising the steps of:

providing a housing and two cells, at least one cell having a weld area;

welding a strap between the two cells; and

disposing the cells in the housing,

wherein the strap is welded by disposing a first electrode on the strap outside the weld area and a second electrode on the at least one cell outside of the weld area, and providing a current between the first and second electrodes.

12. The method of Claim 11, wherein the second electrode contacts a side of the at least one cell.

13. The method of Claim 11, wherein the second electrode contacts a periphery of the at least one cell.

### Discussion

The claims on appeal are directed to a method of making a battery pack comprising two cells connected by a strap and disposed in a housing. At least one of the cells has a "weld area". The strap is welded to the at least one cell at a point outside the "weld area". A first electrode is welded on the strap outside the "weld area". A second electrode is disposed on the at least

one cell at a point outside the “weld area”. Thus, both the first and second electrodes must be disposed outside of the weld area. Current flows between the first and second electrodes.

Appellants' specification cautions that the “weld area . . . may be sensitive to exterior pressure, heat, and electrical current” (Specification, p. 1, last line). Referring to “Prior Art” Figures 1A, 1B and 1C, the specification teaches that “[c]urrent is passed through strap electrode 16S, strap 13 and out the cell 11 into cell electrode 16C, resulting in heat and finally welding” (id., p. 2, ll. 4-5). According to Appellants' specification (id., p. 2, ll. 6-7):

[t]his is problematic because cell electrode 16C partially or completely contacts weld area 11W of cell 11. This welding process may result in early cell failure.

Appellants dispose all electrodes of the two cells of a battery pack manufactured in accordance with Appellants' claimed method outside the “weld area” so as to prevent degradation related to the prior art positioning inside the weld area.

The PTO has the initial burden to establish a prima facie case of obviousness under 35 U.S.C. § 103. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). The PTO can satisfy this burden by showing some objective teaching in the art or prior knowledge in the art which would have lead one of ordinary skill in the art to the invention claimed. *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1599. However, the PTO ever must be cautious not “[t]o imbue one of ordinary skill in the art with knowledge of the invention in suit . . . when no prior art reference or

references of record convey or suggest that knowledge[.] . . . [To do so] is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600, quoting from *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600. That the claimed subject matter lacks complexity is not justification for building a case of obviousness to a person having ordinary skill in the art on a foundation of impermissible hindsight.

Based on the evidence before us, we reverse the Examiner’s rejection of the claimed subject matter for obviousness because, absent knowledge of the invention Appellants claim, we find no combination of the cited prior art teachings which would have directed one of ordinary skill in the art to the invention claimed. First, neither the referenced nor acknowledged prior art teaching recognizes the problem which Appellants’ invention was designed to remedy. Furthermore, the prior art does not appear to provide another reason to carry out the particular method Appellants claim. Compare *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991).

The Examiner relies on the combined teachings of the Alexandres patent, “PRIOR ART” Figures 1A, 1B & 1C of the present application, and the Hooke patent for a reasonable suggestion for a person having ordinary skill in the art to make and use the claimed invention. The Examiner

appears to rely on Hooke solely for its teaching that conventional battery packs were known to have a housing. The Examiner argues that (Answer, p. 4):

[i]n regard to the limitations calling for disposing the cells in a housing, it would have been obvious to have placed the cells of Alexandres . . . in a housing, the motivation being the teachings of Hooke . . . that such is advantageous (see element 20 in figure 8 of Hooke . . .).

According to the Examiner, Alexandres does not show a “weld area” on at least one cell (Answer, pp. 3-4), i.e.,

[t]he claims differ from Alexandres . . . in calling for a cell with “a weld area” (note that in the context of applicant’s invention, the term “weld area” refers to an area of the cell previously welded during the manufacture of the individual cell) and in calling for disposing the cells in a housing. The patent to Alexandres . . . does not discuss the details of cell 44.

Nevertheless, the Examiner submits that (Answer, p. 4)

[a]t the time applicant’s invention was made, it would have been obvious to have practiced the method of Alexandres . . . on any conventional battery cell.

Next, the Examiner finds that (Answer, p. 4):

[a]pplicant acknowledges that cells with pre-existing weld areas are known (see elements 11, 11W in figures 1a, b, c and the discussion at paragraph [0005] in applicant’s specification) . . . [;]

Accordingly, the Examiner concludes that (Answer, p. 4)

[i]t would have been obvious to have practiced the method of Alexandres . . . on a cell with a “weld area”, the well known nature of

which is acknowledged by applicant, the motivation being to secure the advantages of the Alexandres . . . method for such a cell.

The Examiner explains that (Answer, p. 4; emphasis added),

[i]n applying the approach of Alexandres . . . to these prior art cells, at least two of the welding electrodes will necessarily be outside the weld area because figure 3 of Alexandres . . . shows that all electrodes are away from the center of the cell, thereby satisfying this feature of the claim.

The road to the Examiner's conclusion of obviousness has a few holes. We are stuck in the holes in the prima facie case of obviousness.

In Alexandres' Figures 2 and 3, item **44** is a battery, **42** is a battery cap, and **40** is a metal connector strip (Alexandres, col. 3, ll. 4-7). "Welds **66**, **68** and **70** are sequentially formed to electrically bond the connector strip **40** to the battery cap **42**" (Alexandres, col. 3, ll. 16-18). Alexandres refers to welds **66**, **68** and **70** as "weldment areas" (Alexandres, col. 3, ll. 21-29).

We do not readily see, and the Examiner has not adequately explained, how the application of the welding process described by Alexandres can be used to connect conventional batteries of the type shown in Appellants' "Prior Art" Figures 1A, 1B, and 1A via a metal strap and necessarily produce a battery pack with at least one cell having "a first electrode on the strap outside the weld area" and "a second electrode on the at least one cell outside the weld area" as Appellants' Claim 11 requires. We recognize that it is possible for one skilled in the art to make a battery pack made by the process Appellants claim in accordance with Alexandres' teaching if one broadly interprets the phrase "a second electrode on the at least one cell" in Appellants' Claim 11 as the Examiner broadly interprets

the phrase to read on a second electrode in proximity to the at least one cell (Answer, p. 5). However, the Examiner's reading of the critical phrase in the method of Claim 11 appears to be far broader in scope than, and inconsistent with, a reasonable interpretation of the teaching of Appellants' drawings and specification as a whole, including the problems Appellants' claimed invention were designed to solve. "[I]n proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification." *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Furthermore, the possibility that a person having ordinary skill in the art might perform a process incorrectly interpreted to fall within the scope of Appellants' claims while following Alexandres' process is immaterial to the issue of the unpatentability of Appellants' claimed process for obviousness to a person having ordinary skill in the art at the time the application was filed. The teaching of Alexandres combined with the acknowledged prior art, reasonably would not have suggested to a person having ordinary skill in the art all the specific limitations of the process claimed by Appellants, in particular a process wherein both the first and second electrodes must be disposed outside of the weld area. Rather, the Examiner's case for the unpatentability of the process Appellants claim, with all its particular limitations, appears to be based on impermissible hindsight.

CONCLUSION

Having considered all the evidence of record both for and against the patentability of Claims 11-13 of Application 10/643,383 under 35 U.S.C. § 103, we reverse the appealed final rejections. Accordingly, it is

ORDERED that the Examiner's final rejection of Claims 11-13 of Application 10/643,383 is reversed; and

FURTHER ORDERED that this application is remanded to the Examiner for action consistent with the views expressed herein.

REVERSED

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